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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,752	04/17/2001	James D. Bennett	7962.002US4	8896

21186 7590 01/09/2009  
SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
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MINNEAPOLIS, MN 55402

EXAMINER
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KNEPPER, DAVID D

ART UNIT	PAPER NUMBER
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2626

MAIL DATE	DELIVERY MODE
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01/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/837,752	<b>Applicant(s)</b> BENNETT ET AL.	
	<b>Examiner</b> David D. Knepper	<b>Art Unit</b> 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8 sheets</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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1. Applicant's IDS filed on 4 April 2008 has been received and considered. Claims 11-23 are pending.
2. It is unclear which, if any, of the submitted documents are considered useful or necessary since the applicant did not offer any explanation. In particular, the citations of many office actions and applicant responses from other applications may be inappropriate since these are being separately examined and many have matured to patents (i.e. – prosecution on them is closed). It is not appropriate for the Examiner to comment on patented files and the applicant is referred to MPEP sections 1700 and 2700 for consideration regarding corrections or continuing prosecution if the applicant believes any such options are appropriate and/or necessary.

The IDS included papers from 35 applications and that priority is only claimed for 5 of those applications. It is the applicant's responsibility to explain and correct any discrepancies in priority and submissions.

As the Examiner was considering papers from 08/339771 (US patent 5,740,245), a court decision from the US District Court Northern District of Illinois, Eastern Division (Case Number 01 C 6204) was filed in this case on 4 August 2008. The court decision is dated 5 Dec 2005 and provides further insight into the applicability of various references that were cited by the applicant in the latest and earlier filed IDS submissions.

Priority is claimed & prosecution papers (3) considered from IDS [also noted in court case]:

5815639	08/065163
5926787	09/144582
5369704	08/036488

Priority NOT claimed & prosecution papers (9) considered from IDS [also noted in court case]:

5740245	09/339771
5884256	09/057780
5940800	09/144576

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5949952	08/818402
6023675	09/185114
6026395	09/345910
6282510	09/498192
5867186	08/066948
5970141	09/057650

### **Priority Claims**

3. The applicant(s) should check their filing receipts and/or the Patent Application Information Retrieval (PAIR) system for the acknowledgment of their **domestic** priority or benefit claims (if any) under 35 USC 119(e), 120 or 121 (37 CFR 1.78).

### **Claims**

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 11-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for converting stenographic key-codes into regular text form in one language, does not reasonably provide enablement for translation into one or more languages or to perform windows based GUI manipulations. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to perform the invention commensurate in scope with these claims.

Further limitations towards phoneme based translation and/or parsing of different languages is not specifically taught in the specification. Similarly, the specification does not

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teach details for generating different windows or the programming necessary to implement such details.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 11-23 are rejected under 35 U.S.C. § 103 as being unpatentable over Jeppesen (4,924,387) in view of CaseView (1992, CaseView reference manual by Stenograph) Toma (4,706,212).

As per claims 11, 18: “language translation in a transcription system during a testimonial proceeding” is taught or suggested by Jeppesen’s Computerized Court Reporting System:

“receiving into a transcription system, in real-time, representations of words spoken in a first language” (see the abstract that indicates providing simultaneous written and video record under the control of a single court reporter):

“converting, in real-time, said representations to text in the first language” (suggested by Jeppesen who teaches that current state of the art includes increasing speed computers that allow voice recognition removing some chores from the duties of the

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court reporter, col. 7, line 64-col. 8, line 3 – see also CaseView figures on page 3 that show that it is well known to add multiple computers to a network for simultaneous viewing of a transcription in real time to multiple users such as attorneys during a court proceeding);

“translating, in real-time, the text in the first language to text in a second language; and communicating the text in the second language to a terminal for real-time display.” (taught by Toma’s method using a programmed digital computer system for translation between natural languages, title – see also column 8, lines 47-50 where he teaches ...the inventive concepts are applicable to translation between any two natural languages such as English and Chinese, Spanish, etc. ).

It is noted that Jeppesen does not explicitly teach using a terminal for real-time display or translating to a second language. However, he teaches that it is well known to use faster computers to perform more intricate methods that will reduce court reporter duties as noted above. CaseView explicitly teaches that it is well known to use multiple computers in order to allow multiple system users to view data simultaneously using a computer network. Toma teaches that it is well known to use a computer to implement translations between different languages. It would have been obvious for a person having ordinary skill in the pertinent art, at the time the invention was made, to combine the computer based methods of Jeppesen, CaseView and Toma because Jeppesen teaches that it is known to combine computer based methods that are within the state of the art and both CaseView and Toma teach computer based methods that are useful for testimonial proceedings (CaseView) and for translation between languages (Toma).

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Claims 12, 19: See Jeppesen's stenographic machine 10, figure 6.

Claims 13, 20: "attempting to identify exact textual representations" is taught by Jeppesen's generating the transcription in word processing format, col. 2, lines 35-36 and

"in response to failing to identify exact textual representation...identifying phoneme text" (suggested by Jeppesen's stenographic machine which is taught as generating strokes mechanically to avoid confusion ...the strokes 16 are used to indicate a phonetic representation of what is heard and the source thereof, col. 2, lines 3-5);

"translating the identified phoneme text in the first language to phoneme text in the second language" (Toma's figs. 5-6 shows examples of phonetic spellings for conversion).

Claim 14: Parsing is shown by Toma in figures 12-19 for identifying grammar structure between languages.

Claims 15, 17, 21: Enabling different users at different terminals to select language is suggested by Toma in co. 2 lines 51-65 which teaches the only changes for different languages are those necessitated by the inherent structures of the languages...coordinated usage of the various auxiliary devices, which allows easy access to the various dictionaries.

Claims 16, 22: The use of a third language for translation is obvious in view of Toma who teaches that more than 2 languages are possible with his English, Chinese and Spanish as noted above.

Claim 23: Official Notice is taken that it is well known to implement windows based operating systems on computers and therefore, it would have been obvious to utilize windows based displays of any data type on a computer.

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8. Some correspondence may be submitted electronically. See the Office's Internet Web site <http://www.uspto.gov> for additional information.

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Effective 14 January 2005, except correspondence for Maintenance Fees, Deposit Accounts (see 37 CFR 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address correspondence delivered by other delivery services (i.e. – Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Knepper whose telephone number is (571) 272-7607.

The examiner can normally be reached on Monday - Friday from 1-5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth, can be reached on (571) 272-7843.

For the Group 2600 receptionist or customer service call (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) between the hours of 6 a.m. and midnight Monday through Friday EST, or by email at [ebc@uspto.gov](mailto:ebc@uspto.gov). For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

/David D. Knepper/  
Primary Examiner  
**Art Unit 2626**